THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

The opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.

Paper No. 35

UNITED STATES PATENT AND TRADEMARK OFFICE

_____

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

_____

Ex parte JOSEF GOTTLING

_____

Appeal No. 98-1014
Application 08/521,013[1]

_____

ON BRIEF

_____

Before STAAB, NASE and CRAWFORD, Administrative Patent Judges.

STAAB, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on an appeal from the examiner's final rejection of claims 1, 2 and 5-10, all the claims remaining in the application.

---

[1] Application for patent filed August 30, 1995. According to the appellant, the application is a continuation of Application 08/275,811, filed July 15, 1994, now abandoned; which is a continuation of Application 08/064,963, filed May 18, 1993, now abandoned.

Appellant's invention pertains to a method and apparatus for erasing an ink carrying layer from an impervious surface of an image-containing printing form that is usable for offset printing. An understanding of the invention can be derived from a reading of independent method claim 1 and independent apparatus claim 9, copies of which are found in an appendix to appellant's brief.

The references of record relied upon by the examiner in support of rejections under 35 U.S.C. § 103 are:

Gregory et al (Gregory)	3,801,369	Apr. 2, 1974
Roberts	3,800,702	Apr. 2, 1974

IBM Technical Disclosure Bulletin, Vol. No. 8, January 1983, T. A. Bergh et al, pp 4116-4117.[2]

In addition, the examiner relies on appellant's admitted prior art as set forth on pages 2 and 3 of the specification.

Claims 1 and 7-10 stand rejected under 35 U.S.C. § 103 as being unpatentable over appellant's admitted prior art in view of Roberts and Chew. Claims 2, 5 and 6 stand rejected similarly rejected with further reliance on Gregory.

Looking at the rejection of claims 1 and 7-10, the examiner considers (answer, page 3) that appellant admits on pages 2 and 3 of the specification that

---

[2] Both appellant and the examiner refer to this publication by its second named author, Chew. In order to avoid confusion, we will do likewise.

> it is known to use hydrophilic aluminum plate as printing forms for form cylinders in a printing press and such printing forms can be regenerated by erasing the ink residue remaining on the printing form after printing via various known methods so as to render the aluminum printing forms hydrophilic again. However, the detailed method and apparatus for erasing the ink residue from the hydrophilic aluminum printing plate are not given.

The examiner considers that Roberts teaches a method and apparatus for erasing ink residue from the surface of a printing cylinder that includes the use of fixed nozzles 58 for impinging pressurized fresh water against the surface of the printing cylinder, and that Chew teaches a cleaning system that uses high pressure water jets to clean disk surfaces where the water pressure is 2500 to 4000 psi and the impinging angle of the jets relative to the surface of the disks is 20E to 40E. Based on these finding the examiner concludes (answer, page 4) that it would have been obvious

> to provide the appellant's admitted prior art with the ink residue cleaning structure of Roberts with the nozzles arranged at an angle less than 90E with respect to the printing cylinder surface as taught by Chew et al. to achieve improved cleaning result. The mere application of a known way of washing the ink residue off the ink bearing surface of printing cylinder by those having ordinary skill in the art would involve no apparent unobviousness.

With respect to the "pressurized solvent-free water" limitation of claims 1 and 9, the examiner posits (answer, page 4) that "this limitation would be automatically met by the teachings of Roberts and Chew et al. . . ." Concerning the recited pressure requirements for the water jet called for in the claims, the examiner further posits (answer, pages 4-5) that "[e]ven though the applied references may not specify the same pressure setting for the pressurized water jet used in their cleaning operation, the

ultimate pressure setting for the water jet . . . would have been determined through routine experimentation" and "would involve no apparent unobviousness."

As to the claim limitation setting forth that the printing form is simultaneously rendered hydrophilic by the pressurized jet, the examiner maintains (answer, page 5) that said limitation "is inherently met by the teachings of the applied references."

For the reasons that follow, we will not sustain this rejection.

First, the examiner has not clearly identified what constitutes the admitted prior art that forms the basis of the rejection. The bulk of the discussion on page 2 of the specification relates to a method of *applying* an ink carrying layer to a printing forms, and as such would not appear to be particularly relevant to the claimed method and apparatus for *erasing* an ink carrying layer. The paragraph spanning pages 2 and 3 of the specification indicates to us that it is generally known to regenerate a printing form by removing the ink carrying layer from the surface of the printing form, but that this may require an *additional* step of treating the surface of the printing form to again render it hydrophilic. The first full paragraph on page 3 states generally that known methods of removing ink carrying layers are cumbersome and subject the printing cylinder to wear, and the second full paragraph on page 3 indicates that erasing the surface of the printing cylinder usually take place after the printing process. The relevance of these two paragraphs to

the claimed subject matter is not clear. The last two paragraphs on page 3 refer to a method of

regeneration as described in a specific German patent document[3]; however, the examiner has not explained how this German reference might relate to the subject matter of the appealed claims, or to what extent this specific patent document is being relied upon. In light of the broad scope of the discussion found on pages 2 and 3 of the specification, and the generalities of that discussion, the lack of clarity on the examiner's part as to precisely what constitutes the "admitted prior art" makes it difficult to evaluate the examiner's rejection.

Second, the examiner's reliance on Chew is misplaced. Chew specifically pertains to a process for cleaning the surfaces of magnetic disks. Furthermore, Chew does not disclose any particular significance for the disclosed impinging angle of 20E to 40E from the vertical relied upon by the examiner. Notwithstanding these deficiencies in Chew, the examiner appears to be of the view that Chew's impinging angle teaching would be broadly applicable to a method for cleaning a printing form. However, the applied prior art[4] could just as easily be considered to teach that *in the printing arts,* water jets should be oriented at about 90E relative to the surface of the print cylinder to be cleaned. The mere fact that the prior art *could* be modified in a particular way does not make that modification obvious unless the prior art suggested the desirability of the modification. *In re Gordon,* 733 F.2d

---

[3] The document in question is German application 41 23 959.8, which was made of record by appellant in the Information Disclosure Statement filed May 23, 1994 (Paper No. 6), and which was considered by the examiner on September 27, 1994. See the initialed PTO Form 1449 included as an attachment to the Office Action mailed September 28, 1994 (Paper No. 14).

[4] Note water jet nozzles 58 of Roberts.

900, 902, 221 USPQ 1125, 1127 (Fed. Cir. 1984). Here, the prior art does not suggest the desirability, and thus the obviousness, of the proposed modification. Accordingly, we do not consider that the Chew reference would have taught one of ordinary skill in the art that a prior art method and/or apparatus for erasing an ink carrying layer from the surface of a image-carrying printing form should be provided with a cleaning jet inclined at an angle less that 90E relative to the surface of the printing form.

Third, we do not agree with the examiner that the requirement of method claim 1 that the printing form is simultaneously rendered hydrophilic by the pressurized jet is inherently met by the teachings of the applied references. Inherency may not be established by probabilities or possibilities, and the mere fact that a certain thing may result from a given set of circumstances is not sufficient. *In re Oelrich*, 666 F.2d 578, 581, 212 USPQ 323, 326 (CCPA 1981).

In light of the above, the § 103 rejection of claims 1 and 7-10 is not sustainable.

Turning to the § 103 rejection of claims 2, 5 and 6, the Gregory reference additionally applied in this rejection does not render obvious what we have found to be lacking in the evidentiary basis relied upon by the examiner in the rejection of claims 1 and 7-10. Accordingly, this rejection also will not be sustained.

The decision of the examiner is reversed.

REVERSED

LAWRENCE J. STAAB Administrative Patent Judge	))))) BOARD OF PATENT
JEFFREY V. NASE Administrative Patent Judge	)) APPEALS AND)) INTERFERENCES
MURRIEL E. CRAWFORD Administrative Patent Judge	))

LJS/pgg

Thomas C. Pontani
Cohen Pontani Lieberman & Pavane
551 Fifth Avenue Suite 1210
New York, NY 10176